

**Amendments to the Drawings:**

The attached sheets of drawings include changes to Figs. 1, 2, 5, 8, 10 and 11. These sheets, which include Figs. 1, 2, 4, 5, 7, 8, 10, 11 and 12, replace the original sheets including Figs. 1, 2, 4, 5, 7, 8, 10, 11 and 12. In Figs. 1, 2, 5, 8, 10 and 11, the German-language text has been replaced with equivalent English-language text (said English-language text having previously been positioned below the respective figure). Also, in Fig. 2, one of the two occurrences of reference numeral “35” has been replaced with reference numeral “33.” No new matter is added by these changes.

Attachment: Replacement sheets

## REMARKS

Applicants respectfully request reconsideration of the above-identified application in view of the amendment above and the remarks below.

Claims 2-6 and 42 have been canceled in this paper. Claims 1, 7, 8, 41, and 43-45 have been amended in this paper. No new claims have been added in this paper. Therefore, claims 1, 7-41 and 43-45 are pending. Of these claims, claims 8, 10 and 13-40 have been withdrawn as being directed at a non-elected species, as discussed further below. Therefore, claims 1, 7, 9, 11-12, 41 and 43-45 are under active consideration.

The drawings stand objected to for the following reasons:

First, each of figures 1-2, 5, 8, 10 and 11 contains at least one foreign language; Second, in figure 2, the reference "35" is used to refer to two different elements. Should the reference "35" appeared near the references "12" and "34" be changed to -33--?

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature related to the ocular device as claimed in claim 1 and the observation device having a base body as recited in claim 45 must be shown or the features canceled from the claims. No new matter should be entered.

In response to the above, Applicants have amended Figs. 1-2, 5, 8, 10 and 11 so that all foreign-language text has been replaced with English-language text. In addition, Fig. 2 has been amended so that the reference numeral "35" that previously appeared near "12" and "34" has been changed to "33." Furthermore, the language "ocular device" has been removed from claim 1, and the language "base body" has been removed from claim 45; consequently, the drawings and the claims are consistent with one another. No new matter is added by the above changes. In view of the above, the objection to the drawings should be withdrawn.

The disclosure stands objected to for the following alleged informalities:

a) Pages 4-22: The summary of the invention is objected to because it refers to the claims (see page 4) and it contains numerous details of the inventive device. The present summary of the invention longs more than 18 pages. Applicant should provide a brief summary of the invention and provide other details of the inventive device in the section of “Detailed Description of the invention”; b) Page 8: last line of the page, what does the term “PD” mean? c) Page 9: lines 7-8, what does the terms “ad infinitum” mean? d) Page 27: line 21 and line 23, “und” should be changed to –and--; d) Page 27: line 4, “Figure 1” should be changed to –Figure 2--. Applicant should note that figure 2, not figure 1, discloses a box with the numerical reference “45”; e) Page 29: line 19, “Figure 9” should be changed to –Figure 11—because figure 11, not figure 9, discloses prisms “60” and “63”. There are still some grammatical and idiomatic errors in the specification. Applicant should carefully proofread the specification. Appropriate correction is required.

Applicants respectfully traverse the subject rejection. With respect to ground (a) of the rejection, Applicants note that the references in the Summary to the claims have been removed and that most of what had been included in the Summary has now been moved to the Detailed Description. With respect to ground (b), “PD” is no longer recited on page 8. With respect to ground (c), “ad infinitum” is no longer recited on page 9. With respect to ground (d), page 27 has been amended so that “und” has been changed to “and” and so that the reference in question to Figure 1 has been changed to Figure 2. With respect to ground (e), the reference in question to Figure 9 has been changed to Figure 11. If the Patent Office is aware of other issues regarding the specification, Applicants respectfully request that the Patent Office identify those issues so that they may be addressed appropriately.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 1-2, 4, 7, 41, 44 and 45 stand objected to because of the following alleged informalities:

a) Claim 1 fails to conform with current U.S. practice. It appears to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

First, the phrase “A tilting system for an observation device, in particular for a microscope” renders the claim indefinite because it is unclear whether the limitations following the terms “an observation device” is part of the claimed invention. See MPEP § 2173.05(d). Should “, in particular for a microscope,” (line 1) be deleted.

Second, the feature thereof “the extended position of the tilting system (line 7) is unclear. What position is “the extended position” of the tilting system does applicant imply here?

b) Claim 2 is objected to by the recitation thereof “at least one deviating prism is provided in each of the beam paths, upstream and/or downstream of the 180° prism” (lines 1-3).

First, the feature “the beam paths” lacks a proper antecedent basis. Applicant should note that the base claim 1 recites “at least one beam path” (claim 1, line 2) does not mean that the system has plural beam paths as claimed in claim 2. Should the terms “each of the beam paths” be changed to –at least one beam path--?

Second, it is unclear how many deviating prism being used in the system by the mentioned recitation. Applicant should note that the use of the terms “at least one deviating prism” (lines 1-2) could be understood as there is one prism and thus it is either being located upstream or downstream of the 180° prism. It cannot be located on both upstream and downstream of the 180° prism. Should the terms “and/or” be changed to –or--?

c) Claim 4 is objected to because the feature “the deviating prisms” (line 3) lacks a proper antecedent basis. Applicant should note that the base claim 2 recites “at least one deviating prism” (claim 2, lines 1-2) does not mean that the system has plural deviating prisms as claimed in claim 4. Should the terms “the deviating prisms” be changed to –at least one deviating prism--?

d) Claim 7 is objected to for the same reason as set forth in element c) above. Should the terms “the deviating prisms” be changed to –at least one deviating prism--?

e) In each of claims 41 and 44: the term “this” appeared on line 1 of each claim should be changed to –the-- or –said--.

f) Claim 45 is objected to. The phrase “An observation device, in particular a microscope or telescope,” renders the claim indefinite because it is unclear whether the limitations following the terms “an observation device” is part of the claimed invention. See MPEP § 2173.05(d). Should the terms “, in particular a microscope or telescope,” be deleted?

Applicants respectfully traverse the subject rejection. With respect to ground (a) of the rejection, claim 1 has been amended to delete the language “, in particular for a microscope.” In addition, the language “the extended position” is no longer recited in claim 1.

With respect to ground (b), claim 2 has been canceled herein; therefore, the rejection is moot insofar as it pertains to claim 2. However, notwithstanding the above, the limitations of claim 2 have been added to claim 1; consequently, Applicants will address this ground as it pertains to amended claim 1. The Patent Office has suggested that the language “each of the beam paths” be amended to “at least one beam path.” Applicants have adopted this suggestion. Insofar as the Patent Office has also indicated that it is unclear as to how many deviating prisms are located in the system, Applicants note that the claim has been amended to recite that at least one deviating prism is provided in each of the beam paths, upstream and downstream of the 180° prism.

With respect to ground (c), claim 4 has been canceled herein; therefore, the rejection is moot insofar as it pertains to claim 4. However, notwithstanding the above, the limitations of claim 4 have been added to claim 1; consequently, Applicants will address this ground as it pertains to amended

claim 1. The Patent Office has suggested that the language “the deviating prisms” be amended to “at least one deviating prism.” Applicants have adopted this suggestion.

With respect to ground (d), claim 7 has been amended as suggested by the Patent Office so that the language “the deviating prisms” has been replaced with “at least one deviating prism.”

With respect to ground (e), claims 41 and 44 (as well as claim 43) have been amended to replace “this” with “the.”

With respect to ground (f), claim 45 has been amended as suggested by the Patent Office to delete the language “, in particular a microscope or telescope.”

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 1-2, 42-44 and 45 stand rejected under 35 U.S.C. 102(b) “as being anticipated by Kitajima (U.S. Patent No. 4,652,094).” In support of the rejection, the Patent Office states the following:

Kitajima discloses a binocular microscope. The binocular microscope as described in column 2 and shown in figure 1 comprises the following features: An objective lens unit (2) having a tube for supporting an objective lens (9) and a variable magnification lens system (10); a deflecting unit (4) having a housing (16) for supporting a deflecting prism (18); and a pair of binocular eyepiece units (6) which each has a housing (30) for supporting an image forming lens (32), a Porroprism system (34) and an eyepiece lens (36). The light from an object will go through an entrance region in front of the eyepiece units and then go to an exit region wherein an observer/viewer sees the image via the eyepiece lens. Kitajima also discloses a mechanism for fastening the eyepiece units to the deflecting unit as can be seen in columns 2-3 and shown in fig. 2. The eyepiece units act as a tilting system. It is noted that the Porroprism system (34) comprises two Porro prisms wherein the first prism disposed behind the image forming lens (32) extended in a horizontal direction or in a crosswise to an extension position of the Porroprism system and the second Porro prism disposed behind the first Porro prism extended in a vertical direction. Each of the Porro prisms changes the direction of light incident on it by an angle of 180

degrees. The Porroprism system having two Porro prisms tilts and reverses the image provided by the objective lens unit and guides the image to an observer/viewer via the eyepiece lens (36). It is also noted that the second Porro prism disposed behind the first Porro prism acts as a deviating prism and disposed in the light path from the objective lens unit to the eyepiece lenses. Regarding to the base body as recited in present claim 45, it is noted that the present claim does not provided any specific limitation of the base body of the observation device, and it is inherent that the binocular microscope of Kitajima has a base body for supporting the microscope.

Insofar as the subject rejection pertains to claims 2 and 42, the rejection is moot in view of Applicants' cancellation herein of claims 2 and 42. Insofar as the subject rejection pertains to claims 1 and 43-45, Applicants respectfully traverse the subject rejection.

Claim 1 has been amended herein to include the limitations of original claims 2, 4, 5, 6 and 7. The Patent Office has indicated that original claim 7 recites allowable subject matter. Therefore, it follows that claim 1 must also be allowable.

Claims 43-45 depend from claim 1 and, therefore, are patentable for at least the same reasons as claim 1.

Accordingly, for at least the foregoing reasons, the subject rejection should be withdrawn.

Claims 1-6, 9, 11-12, 41, 43-44 and 45 stand rejected under 35 U.S.C. 103(a) "as being unpatentable over Hanzawa (U.S. Patent No. 5,822,114) in view of Matsubara (U.S. Patent No. 4,643,541)."

Insofar as the subject rejection pertains to claims 2-6, the rejection is moot in view of Applicants' cancellation herein of claims 2-6. Insofar as the subject rejection pertains to claims 1, 9, 11-12, 41 and 43-45, Applicants respectfully traverse the subject rejection.

As noted above, claim 1 has been amended herein to include the limitations of original claims 2, 4, 5, 6 and 7. The Patent Office has indicated that original claim 7 recites allowable subject matter. Therefore, it follows that claim 1 must also be allowable.

Claims 9, 11, 12, 41 and 43-45 depend from claim 1 and, therefore, are patentable for at least the same reasons as claim 1.

Accordingly, for at least the above reasons, the subject rejection should be withdrawn.

Claims 7 and 45/7 are said to “be allowable if rewritten to overcome the objection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.”

As noted above, claim 1 has been amended to include the limitations of original claim 7, as well as all intervening claims. Therefore, claim 1 should be allowed. Furthermore, claim 7 has also been amended herein to include the limitations of claims 1, 3, 4, 5, and 6. Applicants respectfully submit that claim 7, as currently presented, is also allowable. Furthermore, because claim 45 depends from claims 1 and 7, claim 45 should also be allowable.

It is respectfully submitted that the present application is now in condition for allowance. Prompt and favorable action is earnestly solicited.

If there are any fees due in connection with the filing of this paper that are not accounted for, the Examiner is authorized to charge the fees to our Deposit Account No. 11-1755. If a fee is



required for an extension of time under 37 C.F.R. 1.136 that is not accounted for already, such an extension of time is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

Kriegsman & Kriegsman

By:



Edward M. Kriegsman

Reg. No. 33,529

30 Turnpike Road, Suite 9

Southborough, MA 01772

(508) 481-3500

Dated: December 19, 2006

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on December 19, 2006.

  
Edward M. Kriegsman